

Remarks

This Amendment is in response to the Restriction Requirement mailed June 16, 2005. Claims 1-50 are pending in this application. Claims 1-50 have been subjected to a restriction requirement. Claims 3, 10, 17, 18 and 45 have herein been canceled. Claims 1, 5, 8, 15, 19, 20, 23, 40 and 43 have herein been amended. New Claims 51-55 have herein been added.

Applicants acknowledge that in view of the appeal brief filed March 10, 2005, prosecution has been reopened, and that a new restriction requirement has been made. Applicants respectfully object to the propriety of the same, as a restriction requirement had been made two years ago on July 15, 2003. That restriction requirement had been withdrawn, and all of the Claims 1-50 had been examined, were the subject of two office actions, and were up on appeal. For these reasons, in addition to the reasons below, Applicants respectfully request that the new restriction requirement be withdrawn.

Nonetheless, in view of the new restriction requirement of Claims 1-50, Applicants provisionally elect, with traverse, to proceed with Group I, Claims 1-14, and further provisionally elect, with traverse, to proceed with Group I(a), Claims 1-7.

The Examiner's restriction requirement states that the application contains claims directed to the following patentably distinct inventions:

Group I: Claims 1-[14], drawn to a flats mail system and methods of using, classified in class 414, subclass 789.9;

Group II: Claims 15-50, drawn to a mail piece handling apparatus and methods of using, classified in class 414, subclass 794.4.

Within Group I, the Examiner has made the following further restriction requirement:

Group I(a): Claims 1-7, drawn to a flats mail system, classified in class 414, subclass 789.9;

Group I(b): Claims 8-14, drawn to a method of handling flat mail, classified in class 414, subclass 802;

Within Group II, the Examiner has made the following further restriction requirement:

Group II(a): Claims 15-39, drawn to a flats mail system, classified in Class 414, subclass 794.4;

Group II(b): Claims 40-50, drawn to a method of handling flat mail, classified in class 414, subclass 814.

For the following reasons, the Examiner's restriction requirements are respectfully traversed.

With respect to Group I and Group II, the Examiner alleges:

Inventions I and II are related as combination and subcombination. ... In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because any means may be used to convey the objects to the device of invention I. The subcombination has separate utility such as sorting the order of the objects in a desired sequence as claimed in claim 15.

It is respectfully submitted that the Examiner's restriction requirement is somewhat unclear. It appears from the above that the Examiner considers Group I the combination and Group II the subcombination. However, prior to this amendment, independent Claim 15 of Group II included a bridge conveyor..., a stack accumulator combining small stacks of mailpieces into a large stack in a desired sequence and transferring the large stack to tray, and an output tray station.... Independent Claim 1 of Group I, prior to this amendment, included only means for combining multiple small stacks into a large stack while maintaining sequence order, and means for transferring the large stack to a tray (both part of the stack accumulator as seen from Claim 15).

As indicated in MPEP 806.05(a), a combination is an organization of which a subcombination or element is a part. All of the elements of independent Claim 15 (conveyor, stack accumulator combining small stacks into large stack in sequence and transferring to a tray, and tray station) are not claimed in independent Claim 1 (means for combining small stacks into large stack in sequence order and means for transferring to tray). Thus, Claim 1/Group I cannot be considered a combination of the “subcombination” of Claim 15. As such, the Examiner’s attempt to establish two-way distinctness is misplaced. The alleged combination Claim 1 does not require the particulars of alleged subcombination Claim 15 because Claim 1 does not include all of the elements of the alleged subcombination of Claim 15, and therefore cannot be considered a combination. In view of the same, a *prima facie* case of restriction between Groups I and II has not been established.

Applicants have herein amended Claims 1 and 15 to clarify the above. In particular, Claim 1 has been amended to clarify that the means for combining and the means for transferring comprise the stack accumulator. Claim 15 has been amended to claim a flats mail autotraying apparatus, to specifically recite the means for combining and the means for transferring, and to delete the bridge conveyor. It is respectfully submitted that restriction of these claims into two groups is improper. Pursuant to MPEP §806.05(c)(II), where the relationship between the claims is such that separately claimed subcombination B_{SP} (stack accumulator with means for combining small stacks into large stack in sequence order and means for transferring to tray, Claim 1) constitutes essential features of the combinations AB_{SP} (“A” being the output tray station, Claim 15) as claimed, the inventions are examinable together. A requirement for restriction between elected subcombination Claim 1 and combination Claim 15 would not be proper, even though the subcombination may have separate utility.

With respect to the further restriction requirement of Groups I(a) and I(b), related as process and apparatus for its practice, the Examiner states it is well known in the art of mail handling to place mail into trays by hand. Pursuant to MPEP 806.05(e), in order to establish that process and apparatus claims are distinct inventions, a showing “(A) that the process *as claimed* can be practiced by hand; ...” must be made. Applicants have amended Claim 8 to claim that the steps are performed by the stack accumulator, not by hand. Accordingly, *as claimed* in amended Claim 8, the process cannot be practiced by hand, and restriction is thus improper. Further, pursuant to MPEP 806.05(e), if the apparatus claims include a claim to “means” for practicing the process, the claim is a linking claim and must be examined with the elected invention. Such is the case with Group I.

With respect to the further restriction requirement of Groups II(a) and II(b), related as process and apparatus for its practice, the Examiner states that sorting and placing mail into a tray is well known in the mail handling art. As best understood, it is assumed that the Examiner is alleging that it is well known in the mail handling art to sort and place mail into a tray *by hand*. Pursuant to MPEP 806.05(e), in order to establish that process and apparatus claims are distinct inventions, a showing “(A) that the process *as claimed* can be practiced by hand; ...” must be made. Amended Claim 40 claims that the steps are performed by the stack accumulator, not by hand. Accordingly, *as claimed* in amended Claim 40, the process cannot be practiced by hand, and restriction is thus improper.

In view of the above amendments, the prosecution history of this application, and for the above discussed reasons, it is respectfully requested that the restriction requirement be withdrawn, and that all of the claims as set forth herein, be further examined together.

The Commissioner is hereby authorized to charge any fees which may be required, including any extension of time fees necessary to make this paper timely, to Deposit Account No. 16-0657.

A postcard is enclosed evidencing receipt of the same.

Respectfully submitted,

PATULA & ASSOCIATES, P.C.

A handwritten signature in black ink, appearing to read "C. T. Riggs Jr.", written in a cursive style.

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